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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,882	09/28/2001	Joseph E. Kaminkow	0112300-761	4286

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EXAMINER	
MARKS, CHRISTINA M	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,882	KAMINKOW ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,15-18,21,29 and 30* is/are rejected.

7)☒ Claim(s) *4-14,19,20,22-28 and 31-39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It does not appear to be disclosed in the specification that a selection can yield *both* a value and a velocity change. The specification discloses both elements but not in combination. The selection can have either of the elements but there does not appear to be adequate support that a selection can have both elements associated with it. The Applicant is invited to point out such support by page and line number if it does exist.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 21, 22, 29, 37, 38, 39 and those dependent therefrom, the plurality of selections is not positively linked to the overall structure as claimed. The selections are a free-floating entity of the gaming machine, as they are not positively connected to the processor. Applicant lacks required elements or structure to clearly delineate the manner in which there is a

relation between the actual gaming device and the plurality of selections that are displayed. Further, Applicant does not state whether a processor/controller presents the plurality of selections, as such, there lacks a positive connection between elements of the game. A manner has not be set forth is which the plurality of selections are established and therefore one of ordinary skill in the art would not be able to ascertain the function of their generation relative to the game and how they are created or what causes them to be created as they are not embodied within the machine and are therefore not linked to the process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (US Publication 2002/0059252).

Yamaguchi discloses a gaming device that has a display (FIG 1, reference 21) a processor that communicates with the display and can offer the player a plurality of selections that are each at least partially sequentially and individually presented to the player for a limited

time period each through the display device (paragraph 20). The player has an input to enable them to accept each selection during a limited time period (paragraph 20). In the end, the player is provided an award that includes values associated with each of their selections accepted during the limited time period (FIG 20). The points are associated with the player selections by being awarded a certain point value based on their accepted choices. Further, the number of selections is predefined the period of time (FIG 16).

Yamaguchi et al. does not disclose displaying the time period to the user; however, it would be obvious to one of ordinary skill in the art to do so as it would aid the player in the game as they would most definitely want to know exactly how long they have to perform their selections or else they may miss a dead line and become easily frustrated by the lack of information present. A skilled artisan would thus be motivated to display the time in order to properly inform their users and to increase satisfaction with the game. Yamaguchi et al. discloses the ability to input but does not specifically disclose a touch screen. Touch screens are known in the art as a method to quickly input data into a device without having to fuss with a mouse or any other types of peripheral devices. Thus, a skilled artisan would be motivated to allow the system of Yamaguchi et al. to accept input in this manner as an alternative construction choice for the system in order to provide an easy to use input system that negates the need for a number of peripherals. Further, construction is a choice and using an alternatively known input method would be the choice of the designer based on the needs and wants for their system. Each selection is associated with a value that is revealed after time period wherein the player is then awarded.

Claims 1-3, 15,17-18, 21 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Press Your Luck (The Original Game Show Page and Roll that Board).

Press Your Luck is a gaming device comprising a display device that necessarily communicates with a processor. The display shows a number of selections that are each at least partially sequentially and individually presented to the player for a limited time via being highlighted when they are presented. The limited time period is indicated to the player by the display illuminating the square for the limited time period in which it is the selection the player can accept. The player is provided with an input device in the form of a button that allows the player to attempt to accept each selection during the limited time period it is selected. The player's award is then associated with each of the selections accepted by the player during the limited time periods. The number of selections a player has is predefined based on the results of another part of the game; however the board includes increase-pick functions that increase the predefined number of selections. The values not accepted by the player are also displayed on the display device during play and after the time periods have passed. The limited time period is based on the highlighting of the selection but the selections also changes the squares intermittently over a predetermined distance associated with the square at a predetermined speed thus resulting in the further limited time periods before the selection is then again shown. Each square is associated with a value, which is revealed after a selection and added to the player's award for each of the values selected. The limited time period is also based on the selection moving at a predefined velocity through a stationary distance as the distance that is the square never changes but the spaces continuously move at a certain velocity around the distance so the selection is also based on this as they can only be highlighted for a limited time as they are constantly moving. Non-accepted selections are revealed only when they are on the predefined distance so when it moves around past the distance, it is revealed at this point. The manner in which the selections are revealed would be a construction choice wherein a skilled artisan is motivated by the wants and desires for their system.

Allowable Subject Matter

Claims 22, 37, and 39 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. Both of these claims result in a selection that yields a change in the timing and pace of subsequent selections. The prior art of record does not disclose or suggest the usage of such features.

Claim 38 would be allowable (for the reasons detailed above) if the Applicant can provide adequate support in the rebuttal of the alleged new matter discussed above.

Claims 4-14, 19-20, 23-28, 31-36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. While the prior art of record discloses the selections can result in a prize or an increased number of picks, there is no disclosure that a selection can yield a speed change factor that increases or decreases the time period associated with at least one subsequent selection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,033,307: Gaming device with a bonus round wherein a character moves around the screen and can be selected by the user. Does not include speed and velocity changes in the matter defined by the Applicant.

US Patent No. 6,237,913: Gaming device wherein a player can choose to accept a square and is awarded a prize. As it is a lottery ticket, there are not speed and velocity changes in the matter defined by the Applicant.

US Publication 2003/0013519: Gaming machine that allows the player to select from a plurality of images each associated with a gaming award. The pieces are stationary and there is no function to cause them to speed up or slow down.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm
May 13, 2004

Teresa Walberg
Supervisory Patent Examiner
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